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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/360,521	07/23/1999	SERGE RESTLE	05725.0446-0	4299

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EXAMINER	
MITCHELL, GREGORY W	

ART UNIT	PAPER NUMBER
1617	

DATE MAILED: 08/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/360,521	RESTLE ET AL.	
	Examiner	Art Unit	
	Gregory W. Mitchell	1617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *08 June 2005*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-47* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-47* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

This Office Action is in response to the Remarks filed June 08, 2005. Claims 1-47 are pending and are examined herein.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

35 USC § 103 Rejection Maintained

Claims 1-32, 34-41 and 43-47 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Decoster (WO 97/46210, using USPN 6451747 as an English language equivalent) ('747) in view of Decoster (WO 97/46211, English translation) ('211) for the reasons set forth in the Office Action dated February 08, 2005.

Applicant argues, "In the Office Action dated November 10, 2003, the Office recognized that Decoster '211 lacks, among other things, an aminated silicone according to the present invention." This argument is not persuasive because Examiner has not argued otherwise. '211 is used, primarily, to show that an aminated silicone in a detergent cosmetic composition for the hair with an meq/g value as instantly claimed is known in the art to be useful therefor. Examiner has relied on '747 to show the aminated silicone as known in the art.

Applicant argues in the Remarks filed June 08, 2005 and the Remarks filed October 27, 2004 that a genus does not anticipate all species therein. This argument is not persuasive as it pertains to the instant rejection.

The MPEP states, "To establish a *prima facie* case of obviousness in a genus-species chemical composition situation, as in any other 35 U.S.C. 103 case, it is essential that Office personnel find some motivation or suggestion to make the claimed invention in light of the prior art teachings ... In order to find such motivation or suggestion there should be a reasonable likelihood that the claimed invention would have the properties disclosed by the prior art teachings." To accomplish this, the MPEP instructs that "Office personnel should:

(A) determine the 'scope of the content of the prior art';

(B) ascertain the 'differences between the prior art and the claims at issue'; and

(C) determine 'the level of ordinary skill in the art.'" See MPEP 2144.08.

In the instant case, the scope and the content of the prior art is such that '747 specifically teaches the exact same formulas as instantly claimed. Both '747 and the instant invention teach formulas wherein (n+m) is equal to between 1 and 2000. Both '747 and the instant invention teach that n and m are between 1-1999 and 1-2000, respectively. The only difference between the prior art and the claims at issue is that the instant claims recite a further limitation wherein the amine number is greater than or equal to 0.4 meq/g. Thus, '747 teaches a genus of aminated silicones wherein the amine number could be anything, whereas the instantly claimed invention is a subgenus thereof wherein the amine number could be anything, so long as it is greater than 0.4 meq/g. Accordingly, the instant invention is related to a substantial portion of the invention set forth in '747. Finally, Examiner has relied on '211 to illustrate the level of

ordinary skill in the art. '211 teaches the use of aminated silicones for an identical use as those set forth in '747 with amine index between 0.01 and 1 meq/g, generally, and the use of an aminated silicone with an amine index equal to 0.5 meq/g, specifically. See Abstract, p. 5, p.31. It is Examiner's position that '211 suggests the claimed amine index values of an aminated silicone as useful in a detergent cosmetic composition for the hair. Therefore, the skilled artisan would have recognized an aminated silicone of '747, possessing an amine index value as claimed, would be useful in the detergent cosmetic composition for the hair. Accordingly, it is Examiner's position that a *prima facie* case of obviousness has been established.

Applicant's arguments that "While example composition A of Decoster '211 is disclosed as having an amine number of approximately 0.5 meq/g, there is no express disclosure that this amine number should be used in all cases or in all applications. Indeed, an amine number as low as 0.1 may be used." This argument is not persuasive because there is no requirement that '211 teach that an amine index value of 0.5 meq/g must always be used. The fact that one of ordinary skill in the art would recognize an aminated silicone with an amine index value of 0.5 meq/g as useful in a detergent cosmetic composition for the hair is sufficient suggestion to render the instant claims obvious over '747.

Applicant's argument that "there is no disclosure that any of the amines containing silicones having formulae distinct from Decoster '211 should have the same or even similar amine numbers, especially when used in compositions distinct from those of Decoster '211." First, it is noted that both '747 and '211 are directed to

detergent cosmetic composition for the hair. It is also noted that, as discussed above, '211 is used only to establish the state of the art. To that end, '211 illustrates that aminated silicones with an amine index of 0.01 to 1 meq/g are useful in detergent cosmetic compositions for the hair and that an aminated silicone with an amine index of 0.5 meq/g is specifically known to be useful therein. Furthermore, as to Applicants' arguments that "the Office attempts to override the apparent preference in ['747] for amine-containing silicones having an amine number of <0.1 meq/g ..." This argument is not persuasive because the amine index values of '747 are within the range as taught to be useful by '211. See Remarks filed October 27, 2004, page 4. Accordingly, one of ordinary skill in the art would have recognized the teachings of '747 as consistent with those of '211 and would have been *further* motivated to look to '211 to determine the skill of the art as it pertained to the amine index values of aminated silicones for use in a detergent cosmetic composition for the hair. Furthermore, it is well established that consideration of a reference is not limited to the preferred embodiments or working examples, but extends to the entire disclosure for what it fairly teaches, when viewed in light of the admitted knowledge in the art, to a person of ordinary skill in the art. *In re Boe*, 355 F.2d 961, 148 USPQ 507 (CCPA 1966); *In re Lamberti*, 545 F.2d 747, 19USPQ 279 (CCPA 1976); *In re Fracalossi*, 681 F.2d 792, 215 USPQ 569 (CCPA 1982); *In re Kaslow*, 707 F.2d 1366, 217 USPQ 1089 (Fed. Cir. 1983).

Applicant's arguments regarding the transparency of the composition are not persuasive because the transparency of a composition is a property thereof. A product

and its properties are inseparable. *In re Papesch*, 315 F.2d 381, 137 USPQ 43 (CCPA 1963).

Claims 33 and 42 stand rejected under 35 U.S.C. 103(a) as being unpatentable over '747 and '211 as applied to claims 1-32, 34-41 and 43-47 above, and further in view of Naito et al. (USPN 5476649) for the reasons set forth in the Office Action dated February 08, 2005.

Applicant's arguments are not persuasive as they pertain to the instant rejection for the reasons set forth above.

Applicant's arguments of the Remarks filed October 27, 2004 as they pertain to Naiko et al. are not persuasive. Naiko et al. teaches specifically branched fatty acids and their derivatives as useful in imparting excellent sensation to hair and preventing hairs from being damaged (Abstract, col. 1, lines 54-67). 18-methyleicosanoic acid is exemplified as a fatty acid useful therein. Accordingly, it would have been obvious to one of ordinary skill in the art to use 18-methyleicosanoic acid therefor. Simply because Naiko et al. exemplifies numerous branched fatty acids as useful therein does not indicate that it would have been beyond the purview of the skilled artisan to realize that the specifically exemplified branched fatty acid would have been useful. Such an argument would suggest that one of ordinary skill in the art would take nothing from Naiko et al. because there are too many examples.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory W Mitchell whose telephone number is 571-272-2907. The examiner can normally be reached on M-F, 8:30 AM - 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on 571-272-0629. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

gwm

SREENI PADMANABHAN
SUPERVISORY PATENT EXAMINER